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09/368,045	08/03/1999	GREGORY MCDONALD	CITI0110	5055
27510	7590	09/22/2004	EXAMINER	
KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. WASHINGTON, DC 20005			KYLE, CHARLES R	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 09/22/2004

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/368,045  
Filing Date: August 03, 1999  
Appellant(s): MCDONALD ET AL.

**MAILED**

SEP 22 2004

**GROUP 3600**

John M. Harrington  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 30, 2004.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims groups do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

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5,220,501	Lawlor et al	6-1993
5,825,856	Porter et al	10-1998

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 13-16, 18, 20, 22-23, 30-31, 33-36, 44-48, 51 and 55-85 rejected under 35

U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on December 30, 2003.

**(11) Response to Argument**

As preliminary comment, the Examiner notes that the references cited in the rejections all function in the environment of electronic bill payment. *Transue et al* is shown to be in this environment by the Title and Summary of the Invention, at least. Likewise, *Lawlor et al* is concerned with such payments as shown at Col. 43, line 48 to Col. 45, line 48. Finally, *Porter et al* processes electronic payments at Figure 13 and Col. 19, line 14 to Col. 20, line 9. The references disclose all limitations of the claims. The Examiner has provided motivations to combine the references that are not challenged by Appellants. Appellants' arguments address the references cited piecemeal.

At page 4 to page 6, Appellants recite the limitations of the independent claims of Group I.

At page 6, first full paragraph, Appellants correctly identify limitations not disclosed by *Transue* that are, however, disclosed by either *Lawlor* or *Porter*.

Appellants' argument begins at the last paragraph of page 6. Assertion is made that *Transue* does not disclose designation of a payee from either a customer-specific payee identification list or a common payee list. This is incorrect. *Transue* discloses a customer

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specific payee identification list at Fig. 2 and Col. 4, lines 21-40. Additionally, *Lawlor* discloses the limitation of a common payee list as noted in the prior Office Action at mid-page 4.

At page 7, first full paragraph, Appellants argue that *Transue* does not disclose rendering of a scheduled bill payment by the bill payment application. This is true. However, the Examiner relied on *Lawlor* for this feature in the prior Office Action at page 4, last paragraph to page 5.

At page 7, first full paragraph, Appellants argue that *Transue* does not disclose automated non-optional handoff of the customer to a service representative for non-automated verification of customer identification. This is true. However, the Examiner relied on *Porter* for this feature. This cite was combined with the teaching of *Transue* of recurring payment, add or change options at page 6 of the prior Office Action. *Transue* did not disclose all limitations recited by Appellants at page 7, lines 9-13; those not disclosed were provided by *Porter*. Appellants fail to address the Examiner's motivation to combine the references.

At page 7, second full paragraph, Appellants describe details of *Lawlor*, but do not explain the relevance of the discussion to the rejections. There is a suggestion that they believe that *Lawlor* teaches away from *Transue* because of these details but do not explain why this might be so. Appellants state that *Lawlor* does not employ voice response or recognition. This feature was disclosed by *Transue* (see Title). Appellants again fail to identify limitations missing from the references and do not address the motivation to combine the references.

At last paragraph, page 7 to page 8, Appellants assert that *Lawlor* does not disclose payee designation from one of two types of lists. Appellants fail to note the citation to *Lawlor* at Col. 10, lines 44-53 which discloses a common pre-selected payee list. Further, *Transue* discloses a

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customer specific payee identification list at Fig. 2 and Col. 4, lines 21-40. The limitation is in the alternative. The prior art cited discloses both types of lists.

At page 8, first full paragraph, Appellants argue that *Lawlor* does not teach the non-optional handoff feature. *Porter* was relied on for this limitation at page 5 of the prior Office Action. Appellants cite passages of *Transue*, but do not explain the relevance of the citation to the combination of references set forth in the rejections.

At page 8, second full paragraph, Appellants argue that *Porter* does not teach designation of a payee from one of two types of lists. As noted above, *Transue* and *Lawlor* were relied on for these list types. Appellants cite passages of *Transue*, but do not explain the relevance of the citation to the combination of references set forth in the rejections. Appellants give no explanation of why the differences in details among the references would render them incompatible. On the contrary, Appellants admit that *Porter* uses the same voice response/recognition as *Transue*.

At page 8, last paragraph, Appellants argue that *Porter* does not teach scheduled bill payment rendering. The Examiner relied on *Lawlor* for this limitation. See the prior Office Action at page 4, last paragraph to page 5. Appellants argue at the last four lines of page 8 to page 9 that *Porter* does not disclose a combination of features for which the Examiner cited *Porter* and *Transue*. Appellants refer to particular passages of *Porter* without explaining the relevance of the citation to the rejections.

At page 8, first full paragraph, Appellants state that the references do not disclose or suggest the combination of limitations of the independent claims. As shown above, all limitations are disclosed. In each case above where Appellants assert that a limitation is missing

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from a reference, it is found in *another* reference that was actually relied on and cited in the rejections. Appellants fail to provide *any* argument against the combination of the references to reject the claims.

At page 9, last paragraph to page 10, first full paragraph of the Brief, Appellants recite the limitations of the Claims of Group II.

Appellants describe elements of *Transue* at last paragraph of page 10 and then enumerate a number of elements allegedly absent from *Transue*; most are present in *Transue* and *Porter* discloses the rest. As noted before, the Examiner relied on *Porter* for the non-optional handoff of a customer for non-automated verification of identification; *Transue* was cited for the other elements.

At the first full paragraph of page 11, Appellants recite limitations of various claims, but do not relate these recitations to the rejections of the prior Office Action.

At the last paragraph of page 11 to page 12, Appellants describe *Transue* but do not relate the discussion to the rejections.

At page 12, first full paragraph, Appellants assert that *Transue* and *Lawlor* do not disclose the non-optional handoff limitation for which the Examiner cited *Porter* at page 5 of the prior Office Action.

At page 13, first full paragraph, Appellants again argue that a combination of features is not disclosed by two of the references, when three were cited. As set forth in the prior Office Action, *Transue* discloses the invention substantially as claimed. The Examiner then cited *Lawlor* for a common payee list and the rendering feature; *Porter* was cited for the non-optional

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handoff limitation. Appellants incorrectly state that the Examiner considered that *Porter* discloses the recurring, add or change payee options.

As to Appellants' arguments at the third paragraph of page 13, *Transue* and *Lawlor* were relied on for the common payee list and customer specific payee identification lists, not *Porter*. In the following paragraph, Appellants argue that *Porter* is devoid of mention of the scheduled bill payment feature that was actually disclosed by *Lawlor* and cited at the last paragraph of page 4 to page 5 of the prior Office Action. Following this, Appellants again present similar argument and an unconnected reference to *Porter*.

As Appellants have failed to identify any limitation missing from the prior art of record and have not addressed the Examiner's motivations to combine the references, a *prima-facie* case of unpatentability of the claims has been made.

For the above reasons, it is believed that the rejections should be sustained.




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Respectfully submitted,

Charles Kyle  
September 17, 2004



Conferees

  
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